

Remarks

The following remarks are submitted to address the issues raised in the Office Action mailed September 2, 2003.

Claims 1-38 are pending in the present application.

Claims 25-38 were withdrawn from consideration by the Examiner after Applicants elected the compound of Example 9.

Claims 1, 2 and 19-24 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particular point out and distinctly claim the subject matter which the Applicants regarded as the invention.

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(a) as being anticipated by 14 references.

Claims 1, 2 and 19-24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by 27 references.

Claims 1, 2 and 19-24 stand rejected under 35 U.S.C. § 103(a) as being obvious over WO 98/27108 to Yatabe et al.; US Pat. No. 5,703,092 to Xue et al.; FR 1,476,560 to Chimetron; and US Pat. No. 3,255,202 to Johnson, taken alone or in combination with each other when similar utilities are asserted.

Claims 3-18 were considered to be allowable by the Examiner but were objected to as being dependent on a rejected claim.

No new matter has been added. The foregoing rejections and other items in the Office Action are addressed in the following paragraphs. Consideration of the pending claims is respectfully requested in view of the following comments.

Claim Amendments

Claims 1 and 2 have been amended to include the phrase “wherein at least one of R₅, R₆, R₇, and R₈ is -Y-C₁₋₆ alkylene-NR₁₃R₁₄.” Support for this limitation can be found in Examples 1-16. In these Examples, each compound comprises a benzimidazole ring substituted by at least one group of the formula -Y-C₁₋₆ alkylene-NR₁₃R₁₄.

Claims 1 and 2 have also been amended to include Markush type language and to clarify the definition of various R groups.

New Claim

Applicants request entry of new claim 39. Support for new claim 39 can be found in species described in Examples 1-4, 7-9, and 10-16, where each compound includes either a -C₁₋₆ alkyl or a -C₁₋₆ alkylaryl at the R₄ position. Further, support for new claim 39 can be found in the US Provisional Application Serial No. 60/273,377 on page 35, line 21-25, where R₄ is defined as being selected from a) -aryl; b) -C₁₋₆ alkyl; c) -C₁₋₆ alkylaryl; or d) -C₁₋₆ alkoxyaryl.

Election with Traverse

Contrary to the Examiner's statement, Applicants have distinctly and specifically pointed out error in the Examiner's restriction requirement, and the Applicants respectfully submit that the Examiner's treatment of the election as an election without traverse was in error. In the previous response, Applicants distinctly and specifically stated their belief that the restriction requirement was in error because “searching each group would not be unduly burdensome.”

Priority

Applicants do not agree with the Examiner's assertion regarding priority. However, in the absence of an intervening reference relevant to the issue of the scope of R₃ and R₄ that deserves the benefit of priority of the March 5, 2001 provisional filing date, Applicants reserve the right to address this issue in the future.

Claims 1, 2 and 19-24 - 35 U.S.C. § 112, second paragraph

The rejection of claims 1, 2 and 19-24 under 35 U.S.C. § 112, second paragraph, as being indefinite is respectfully traversed. Claims 1 and 2 have been amended to include Markush type language.

Claims 1 and 2 - 35 U.S.C. § 102(a)

The rejection of claims 1 and 2 under 35 U.S.C. § 102(a) as being anticipated by 14 references is respectfully traversed.

Claims 1 and 2 have been amended to include the limitation "wherein at least one of R₅, R₆, R₇, and R₈ is -Y-C₁₋₆ alkylene-N-(C₁-C₆ alkyl)₂." None of the references cited by the Examiner disclose a compound wherein the benzimidazole ring includes at least one group of the formula -Y-C₁₋₆ alkylene-N-(C₁-C₆ alkyl)₂.

Claims 1, 2 and 19-24 - 35 U.S.C. § 102(b)

The rejection of claims 1, 2 and 19-24 under 35 U.S.C. § 102(b) as being anticipated by 27 references is respectfully traversed.

Claims 1 and 2 have been amended to include the limitation "wherein at least one of R₅, R₆, R₇, and R₈ is -Y-C₁₋₆ alkylene-NR₁₃R₁₄." None of the references cited by

the Examiner disclose a compound wherein the benzimidazole ring includes at least one group of the formula -Y-C₁₋₆ alkylene-NR₁₃R₁₄.

Claims 1, 2 and 19-24 - 35 U.S.C. § 103(a)

The rejection of claims 1, 2 and 19-24 under 35 U.S.C. § 103(a) as being obvious over WO 98/27108 to Yatabe et al.; US Pat. No. 5,703,092 to Xue et al.; FR 1,476,560 to Chimetron; and US Pat. No. 3,255,202 to Johnson, taken alone or in combination with each other when similar utilities are asserted is respectfully traversed.

Claims 1 and 2 have been amended to include the limitation “wherein at least one of R₅, R₆, R₇, and R₈ is -Y-C₁₋₆ alkylene-NR₁₃R₁₄.” None of the references cited by the Examiner either alone or in combination suggest or teach modifying a benzimidazole ring to include at least one group of the formula -Y-C₁₋₆ alkylene-NR₁₃R₁₄.

Claims 3-18 - Objection

Claims 3-18 were considered to be allowable by the Examiner but were objected to as being dependent on a rejected claim. Applicants respectfully traverse the objection to claims 3-18.

Claims 3-18 depend from claim 2 and ultimately depend from claim 1. As described above, Applicants have traversed each and every rejection of claims 1 and 2.

Fees

A one month extension fee is included with this Response as this Response is filed prior to end of the four month statutory period for reply on January 2, 2004.

Conclusion

In conclusion, Applicants request entry of the Amendments, consideration of the Remarks, and passage of the application to issuance.

Respectfully submitted,

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